

FORM PTO-1390
(REV. 01-2003)

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE

TRANSMITTAL LETTER TO THE UNITED STATES
DESIGNATED/ELECTED OFFICE (DO/EO/US)
CONCERNING A FILING UNDER 35 U.S.C. 371

ATTORNEY'S DOCKET NUMBER

04661/HG

U.S. APPLICATION NO. (If known, see 37 CFR 1.5

10/509549

INTERNATIONAL APPLICATION NO.
PCT/JP03/03928INTERNATIONAL FILING DATE
28 March 2003PRIORITY DATE CLAIMED
29 March 2002

TITLE OF INVENTION

k opioid Receptor Agonist Comprising 2-Phenylbenzothiazoline Derivative

APPLICANT(S) FOR DO/EO/US Maki TOKAI; Takahiro HONDA; Masashi NIWA; Yaeko OSUMI;
Ken-ichi FUJIMURA; Shin-ichi KOHNO

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (21) indicated below.
4. ☒ The US has been elected (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371(c)(2))
 - a. ☐ is attached hereto (required only if not communicated by the International Bureau).
 - b. ☒ has been communicated by the International Bureau.
 - c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☒ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
 - a. ☒ is attached hereto.
 - b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☐ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371(c)(3))
 - a. ☐ are attached hereto (required only if not communicated by the International Bureau).
 - b. ☐ have been communicated by the International Bureau.
 - c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
 - d. ☐ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371 (c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371(c)(4)).
10. ☐ An English language translation of the annexes of the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371(c)(5)).

Items 11 to 20 below concern document(s) or information included:

11. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. ☒ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. ☒ A preliminary amendment.
14. ☐ An Application Data Sheet under 37 CFR 1.76.
15. ☐ A substitute specification.
16. ☒ A change of correspondence address (Form PTO/SB/122)
17. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13ter.2 and 37 CFR 1.821 - 1.825.
18. ☐ A second copy of the published international application under 35 U.S.C. 154(d)(4).
19. ☐ A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
20. ☒ Other items or information:

(a) REQUEST FOR PUBLICATION OF ASSIGNMENT INFORMATION

- (b) copy of Form PCT/IB/301 for PCT/JP03/03928
- (c) copy of Form PCT/IB/304 for PCT/JP03/03928
- (d) copy of Form PCT/IB/308 for PCT/JP03/03928
- (e) copy of Form PCT/IB/332 for PCT/JP03/03928
- (f) copy of the first page of WO 03/082840, the published application of PCT/JP03/03928
- (g) copy of Form PCT/ISA/210, the International Search Report (in English) for PCT/JP03/03928

Express Mail Mailing Label

No.: EV 443 226 855 US

Date of Deposit: September 28, 2004

I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Dorothy DeFrancesco
Dorothy DeFrancesco

U.S. APPLICATION NO. 10/509549

INTERNATIONAL APPLICATION NO.
PCT/JP03/03928ATTORNEY'S DOCKET NUMBER
04661/HG21. ☒ The following fees are submitted:**BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) - (5)):**Neither international preliminary examination fee (37 CFR 1.482)
nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO
and International Search Report not prepared by the EPO or JPO. \$1080.00International preliminary examination fee (37 CFR 1.482) not paid to
USPTO but International Search Report prepared by the EPO or JPO \$920.00International preliminary examination fee (37 CFR 1.482) not paid to USPTO
but international search fee (37 CFR 1.445(a)(2)) paid to USPTO \$770.00International preliminary examination fee (37 CFR 1.482) paid to USPTO
but all claims did not satisfy provisions of PCT Article 33(1)-(4) \$730.00International preliminary examination fee (37 CFR 1.482) paid to USPTO
and all claims satisfied provisions of PCT Article 33(1)-(4) \$100.00**ENTER APPROPRIATE BASIC FEE AMOUNT =****CALCULATIONS PTO USE ONLY**

\$ 920.00

Surcharge of \$130.00 for furnishing the oath or declaration later than 30 months
from the earliest claimed priority date (37 CFR 1.492(e)).

\$

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE	\$
Total claims	29 - 20 =	9	x \$18.00	\$ 162.00
Independent claims	5 - 3 =	2	x \$86.00	\$ 172.00
MULTIPLE DEPENDENT CLAIM(S) (if applicable)				\$ 290.00
TOTAL OF ABOVE CALCULATIONS =				\$1,544.00

☐ Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above
are reduced by 1/2.

\$

SUBTOTAL =

\$

Processing fee of \$130.00 for furnishing the English translation later than 30 months
from the earliest claimed priority date (37 CFR 1.492(f)).

\$

TOTAL NATIONAL FEE =

\$

Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be
accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). \$40.00 per property +

\$

TOTAL FEES ENCLOSED =

\$

Amount to be
refunded:

\$

charged:

\$

a. ☒ A check in the amount of \$ 1,584.00 to cover the above fees is enclosed.b. ☐ Please charge my Deposit Account No. _____ in the amount of \$ _____ to cover the above fees.
A duplicate copy of this sheet is enclosed.c. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any
overpayment to Deposit Account No. 06-1378. A duplicate copy of this sheet is enclosed.d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. Credit card
information should not be included on this form. Provide credit card information and authorization on PTO-2038.**NOTE:** Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137 (a)
or (b)) must be filed and granted to restore the application to pending status.SEND ALL CORRESPONDENCE TO:
FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.
767 Third Avenue - 25th Floor
New York, NY 10017-2023**CUSTOMER NO: 01933**

Tel. No. (212) 319-4900

Fax No. (212) 319-5101

SIGNATURE

Richard S. Barth

NAME

28,180

REGISTRATION NUMBER

Date: September 28, 2004

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Applicants : Maki TOKAI et al.
Serial No. : To be assigned (U.S. National
Phase of PCT/JP03/03928)
Filed : Concomitantly Herewith
For : κ opioid Receptor Agonist
Comprising 2-Phenylbenzo-
thiazoline Derivative
Docket No. : 04661/HG
Customer No.: 01933

**REQUEST FOR PUBLICATION OF
ASSIGNMENT INFORMATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

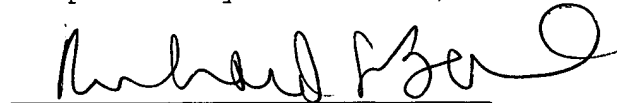
ATTENTION: MAIL STOP PCT

S I R :

It is requested that the following assignment information be published as part of the 18-month publication of the present application:

SANTEN PHARMACEUTICAL CO., LTD.
9-19, Shimoshinjo 3-chome, Higashiyodogawa-ku,
Osaka-shi, Osaka 533-8651 Japan .

Respectfully submitted,



Richard S. Barth
REG. NO. 28,180

FRISHAUF, HOLTZ, GOODMAN & CHICK, P.C.
767 THIRD AVENUE - 25TH FLOOR
NEW YORK, NEW YORK 10017-2023
Tel. Nos. (212) 319-4900
(212) 319-4551/Ext. 219
Fax No. (212) 319-5101
E-Mail Address: BARTH@FHGC-LAW.COM
RSB/ddf

Express Mail Mailing Label
No.: EV 443 226 855 US
Date of Deposit: September 28, 2004
I hereby certify that this paper is
being deposited with the United States
Postal Service "Express Mail Post
Office to Addressee" service under
37 CFR 1.10 with sufficient postage
on the date indicated above and is
addressed to the
Commissioner for Patents,
P.O. Box 1450,
Alexandria, VA 22313-1450


Dorothy DeFrancesco

In the event that this Paper is late
filed, and the necessary petition
for extension of time is not filed
concurrently herewith, please consider
this as a Petition for the requisite
extension of time, and to the extent
not tendered by check attached hereto,
authorization to charge the extension
fee, or any other fee required in
connection with this Paper to
Account No. 06-1378.

DT Rec'd PCT/PTO 28 SEP 2004

PTO/SB/122 (10-00)

Please type a plus sign (+) inside this box → [+]

Approved for use through 10/31/2002. OMB 0651-0035
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CHANGE OF CORRESPONDENCE ADDRESS Application Address to: Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number	To be assigned (U.S. National Phase of PCT/JP03/03928)
	Filing Date	Concomitantly Herewith
	First Named Inventor	Maki TOKAI
	Group Art Unit	
	Examiner Name	
	Attorney Docket Number	04661/HG

Please change the Correspondence Address for the above-identified application to:

☒ Customer Number [01933] →

Type Customer Number here

OR

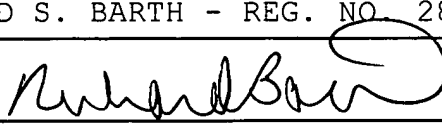
<input type="checkbox"/> Firm or Individual Name					
Address					
Address					
City		State		ZIP	
Country					
Telephone				Fax	

This form cannot be used to change the data associated with a Customer Number. To change the data associated with an existing Customer Number use "Request for Customer Number Data Change" (PTO/SB/124).

I am the:

- ☐ Applicant/Inventor.
☐ Assignee of record of the entire interest.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).

☒ Attorney or Agent of record.☐ Registered practitioner named in the application transmittal letter in an application without an executed oath or declaration. See 37 CFR 1.33(a)(1). Registration Number _____.

Typed or Printed Name	RICHARD S. BARTH - REG. NO. 28,180
Signature	
Date	September 28, 2004

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required. See below.

☒ Total of 1 form is submitted.

Burden Hour Statement: This form is estimated to take 3 minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450